

REMARKS

Claims 1-7, 9-12, 14, 73-80, 133-140 and 195-200 were previously pending. Applicants respectfully request reconsideration of the instant application in the view of the preceding amendments and/or the following remarks. By this Amendment/Response, new claim 201 has been added and claim 200 has been withdrawn. Applicants submit that support for the new claim may be found throughout the originally filed specification, drawings and claims and that no new matter has been added by way of this Amendment/Response. Applicants explicitly reserve the right to add/pursue the claims as originally filed at a later time and/or in one or more continuation applications. Claims 1-7, 9-12, 14, 73-80, 133-140 and 195-199 and 201 are currently pending.

Elections/Restrictions

Claim 200 has been withdrawn by the Examiner based on the Examiner's allegation that the claim "is independent or distinct from the invention originally claimed." (May 29, 2009 Office Action, p. 2, § 2). Although Applicants respectfully traverse this restriction, submit that the pending restriction has not established both that the claims are independent or distinct and that there would be a serious burden to examine both, and submit that the claims could not have been restricted had they been presented earlier, Applicants have complied with the Examiner's restriction requirement and have withdrawn claim 200 to expedite prosecution.

Specification

The specification has been objected to as allegedly containing particular informalities. Specifically, the Examiner has objected to alleged violations of "the proper language and format for an abstract of the disclosure." (May 29, 2009 Office Action, p. 5, ¶ 2). Applicants have amended the specification, providing a replacement Abstract, to provide clarification and expedite prosecution. Accordingly, Applicants submit that the Examiner's objections to the specification have been overcome.

Rejections under 35 USC § 112

Claim 11 has been rejected under 35 U.S.C. § 112 ¶ 2 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner has alleged with regard to claim 11 that she "is unable to determine if it is the customer or seller who is accepting or rejecting said offer or making a counter offer in said cobranded website." (May 29, 2009 Office Action, p. 6, § 1). Although Applicants respectfully traverse this rejection and submit that the original claim is clear and definite, Applicants have amended claim 11 to provide clarification and/or better track practical implementations. Amended claim 11 recites, *inter alia*, "accepting or rejecting said offer by an offeree receiving said offer or making a counteroffer by the offeree." Applicants submit that amended claim 11 is clear and definite and, accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Rejections under 35 USC § 102

Claims 1, 5, 9-11, 73, 77, 80, 133, 137, 140, 195 and 199 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Forward, U.S. Patent no. 6,578,011 (hereinafter, "Forward"). Applicants respectfully traverse this rejection and submit that a *prima facie* showing of anticipation has not been established and that Forward fails to discuss or render obvious every element of each pending claim.

Independent claim 1 recites, *inter alia*,

A method for using a computer to facilitate an on-line bounce back transaction, comprising:

...
receiving a seller acceptance of said conditional purchase offer for said first product or service and subsequently receiving a bounce back offer associated with the first product or service to acquire a second product or service as part of an independent bounce back transaction with a hyperlink to a cobranded web site; and
...

Applicants submit that at least these elements recited in independent claim 1 are not anticipated or rendered obvious by the applied references. The pending rejection alleges,

Forward discloses ... receiving a seller acceptance of said conditional purchase offer for said first product or service and subsequently and [sic] a bounce back offer associated with the first product or service to acquire a second product or service as part of an independent bounce back transaction with a hyperlink to a cobranded web site (col. 2, lines 11-17; col. 2, lines 52-67; ol. 4, line 50-col. 5, line 3; FIG. 4); (May 29, 2009 Office Action, pp. 6-7, § 4)

Applicants respectfully traverse this rejection and submit that Forward is directed to "promoting products to prospective customers, and instructing and enticing those prospective customers to deal with specific merchants by offering the customers a valuable incentive that is redeemable when the customer purchases from the specific merchant" (Forward, col. 1, lines 10-15). Forward's system includes an "item locator" (see element 12 in Figs 1-2) comprising a

repository of information about items for sale, wherein "[a]long with each item, the user may be presented with an incentive to execute the purchase," and once the "user ... executes the purchase with the seller, and receives a proof of purchase," "the user may then advise the system operator of his purchase, and the operator ... provides the purchaser with the valuable reward promised." (Forward, col. 4, lines 27-38). Applicants submit that the incentive in Forward is not analogous to "a bounce back offer," as recited in independent claim 1. However, even if, *in arguendo*, the incentive were analogous to "a bounce back offer", the incentive is presented alongside the offer for the item itself before purchase of the item in order to encourage consummation of the sale of the item. Nowhere does Forward discuss or render obvious, "receiving a seller acceptance of said conditional purchase offer ... and subsequently receiving a bounce back offer," as recited in independent claim 1. Forward's failure to discuss or render obvious at least these claim elements is further demonstrated by element 205 of Fig. 3, which states, "New House Information and Incentive Presented to Potential Buyer," and by Fig. 4 which shows both the incentive and the item being presented to a potential buyer at the same time in a mock user interface screen. Furthermore, Applicants submit that redemption of the proof of purchase to receive the incentive after purchase of the item (see, e.g., Forward, elements 212 and 218 of Fig. 3) is plainly not analogous to "a bounce back offer," as recited in independent claim 1. Applicants also submit that the buyer in Forward's system accepts the seller's offer of sale and the incentive offer simultaneously as part of the same transaction, and thus there is no "bounce back offer ... to acquire a second product or service as part of an independent bounce back transaction," as recited in independent claim 1.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis

added]. As Forward plainly fails to anticipate or render obvious every element of independent claim 1, Applicants respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request that the Examiner unambiguously identify those aspects of Forward alleged to be analogous to "subsequently receiving a bounce back offer" and "an independent bounce back transaction," as recited in independent claim 1, so that Applicants can fully understand the rejection and address the Examiner's concerns at the earliest opportunity.

Although of different scope than claim 1, Applicants submit that independent claim 73 is also not anticipated or rendered obvious by Forward. For example, independent claim 73 recites, *inter alia*,

A computer device for facilitating an on-line bounce back transaction, comprising:

...

(ii) receive a seller acceptance of said conditional purchase offer for said first product or service and subsequently receive a bounce back offer associated with the first product or service to acquire a second product or service as part of an independent bounce back transaction with a hyperlink to a cobranded web site; and

...

Applicants submit that Forward fails to anticipate or render obvious at least these elements recited in independent claim 73 for at least similar reasons as those discussed above identifying deficiencies in Forward with regard to independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claim 1, Applicants submit that independent claim 133 is also not anticipated or rendered obvious by Forward. For example, independent claim 133 recites, *inter alia*,

A computer readable medium for facilitating an on-line bounce back transaction, comprising:

...

code executable by the processor for receiving a seller acceptance of said conditional purchase offer for said first product or service and subsequently receiving a bounce back offer associated with the first product or service to acquire a second product or service as part of an independent bounce back transaction with a hyperlink to a cobranded web site; and

...

Applicants submit that Forward fails to anticipate or render obvious at least these elements recited in independent claim 133 for at least similar reasons as those discussed above identifying deficiencies in Forward with regard to independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claim 1, Applicants submit that independent claim 195 is also not anticipated or rendered obvious by Forward. For example, independent claim 195 recites, *inter alia*,

A processor-implemented method for facilitating an independent on-line bounce back transaction spawned from an initial transaction, comprising:

...

receiving a seller acceptance of said conditional purchase offer for said first product or service and subsequently receiving a bounce back offer associated with the first product or service, wherein the bounce back offer is configured to initiate a subsequent transaction to acquire a second product or service with a hyperlink to a cobranded web site; and

...

Applicants submit that Forward fails to anticipate or render obvious at least these elements recited in independent claim 195 for at least similar reasons as those discussed above identifying deficiencies in Forward with regard to independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Furthermore, Applicants submit that claims 5, 9-11, 77, 80, 137, 140 and 199, which depend from independent claims 1, 73, 133 and 195, are also not anticipated or rendered obvious by Forward for at least similar reasons as those discussed above identifying deficiencies in Forward with regard to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Rejections under 35 USC § 103

Claims 2, 3, 74, 75, 134, 135, 196 and 198 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Forward in view of the Examiner's invocation of Official Notice; claims 4, 6, 7, 76, 78, 79, 136, 138 and 139 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Forward in view of Microsoft Office 2000 Professional Edition (hereinafter, "MS Office"); claim 12 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Forward; claim 14 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Forward in view of Logan et al., U.S. Patent no. 6,199,076 (hereinafter, "Logan"); and claim 197 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Forward in view of Official Notice and in further view of MS Office. Applicants respectfully traverse these rejections and submit that a *prima facie* showing of obviousness has not been established and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each pending claim.

Applicants submit that claims 2, which depend from independent claims 1, 73, 133 and 195, are also not discussed or rendered obvious by Forward for at least similar reasons as those discussed above identifying deficiencies in Forward with regard to the independent claims. Applicants further submit that neither the Examiner's Official Notice, directed to "conditional

purchase offers for airline tickets, hotel rooms, or rental cars"; MS Office; nor Logan, directed to an audio program scheduling and distribution system, remedy the deficiencies in Forward discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-7, 9-12, 14, 73-80, 133-140 and 195-199 and 201, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserve the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such

re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized and requested to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-067US1. In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-067US1.

Respectfully Submitted,
CHADBOURNE & PARKE, L.L.P.

Date: November 25, 2009

BY: /Walter G. Hanchuk/
Walter G. Hanchuk
Registration No. 35,179

Address:
Chadbourne & Parke, L.L.P.
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 Telephone
212-541-5369 Facsimile